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Bottorff

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ghent Manufacturing, Inc.

Serial No. 75/450,847

David Josephic of Wood, Herron & Evans, LLP for Ghent
Manufacturing, Inc.

Mary Boagni, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney)

Before Simms, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On March 16, 1998, applicant, an Ohio corporation,
filed an application by which it seeks registration on the
Principal Register of the mark LINEA ITALIA for goods
identified in the application, as amended, as "furniture,
namely, mobile and stationary computer workstations
comprised of shelving, storage and filing systems for
computer peripherals, keyboard platforms, computer hardware
and computer software." According to the application,

LINEA ITALIA translates into English as ITALY LINE.

Applicant has disclaimed the exclusive right to use LINEA apart from the mark as shown.

The Trademark Examining Attorney initially refused registration on the ground that applicant's mark is either primarily geographically descriptive of applicant's goods and thus barred from registration under Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2), or else it is primarily geographically deceptively misdescriptive of applicant's goods and thus barred from registration under Trademark Act Section 2(e)(3).¹ In its response to the initial office action, applicant stated that its goods do not originate in Italy. The Trademark Examining Attorney then withdrew the Section 2(e)(2) refusal, but made her Section 2(e)(3) refusal final. Applicant requested reconsideration, but the Trademark Examining Attorney

¹ Trademark Act Section 1052(e) provides, in relevant part, as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -

(e) Consists of a mark which, ... (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them ..., [or] (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them ...

maintained her final refusal. Applicant then filed this appeal.

Applicant and the Trademark Examining Attorney filed main briefs; applicant did not file a reply brief, nor did applicant request an oral hearing. We have carefully considered all of the evidence of record and the arguments made by applicant and by the Trademark Examining Attorney. We find that the Trademark Examining Attorney has established a prima facie case in support of her primarily geographically deceptively misdescriptiveness refusal, and that applicant has failed to rebut that prima facie case. Accordingly, we affirm the refusal to register.

"Whether a mark is primarily geographically deceptively misdescriptive ... requires an analysis under a two prong test to establish (1) whether the primary significance of the mark as it is used is a generally known geographic place; and (2) whether the public would make a 'goods/place association,' i.e., believe that the goods for which the mark is sought to be registered originate in that place." *Institut National Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992). See also *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

We find that the Trademark Examining Attorney has established, prima facie, the first prong of her refusal, i.e., that the primary significance of applicant's mark LINEA ITALIA is that of a generally known geographic place. ITALIA is Italian for ITALY, as is shown by the geographic dictionary evidence made of record by the Trademark Examining Attorney² and by applicant's own translation of the mark in the application. As applicant has acknowledged³, ITALIA or ITALY is, of course, a "large, well-known country" which is neither obscure nor remote.

Applicant's translation statement also shows that LINEA is Italian for LINE. The Trademark Examining Attorney has presented evidence showing that "line" is defined, inter alia, as "merchandise or services of a similar or related nature: *carries a complete line of small tools*."⁴ She also has submitted evidence from the NEXIS® automated database showing use of "line" in this manner in conjunction with "furniture," e.g.: "...the latest outdoor furniture lines"⁵; "[h]e describes his furniture line as

² Webster's New Geographical Dictionary (1988), p.556.

³ August 26, 1999 request for reconsideration, p.2.

⁴ The American Heritage® Dictionary of the English Language (3d Ed. 1992).

⁵ Asheville [NC] Citizen-Times, March 6, 1999.

'the rustic chic collection'..."⁶; and "Ethan Allen just announced plans to launch a children's furniture line..."⁷

Based on this evidence, we find that LINEA or LINE, as it is used in applicant's mark and in conjunction with applicant's goods, is a generic or highly descriptive designator which is devoid of any source-indicating significance. Its presence in applicant's mark LINEA ITALIA does not detract from or negate the primarily geographic significance of the mark. See *In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652 (Fed. Cir. 1993)(FRENCH LINE found to be primarily geographic as applied to numerous goods and services). See generally *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1074 (TTAB 1988); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986).

For the reasons discussed above, we find that the primary significance of applicant's mark LINEA ITALIA is that of a generally known geographic place, i.e., Italy, and that the Trademark Examining Attorney has established this first prong of the Section 2(e)(3) refusal.

⁶ Richmond Times Dispatch, March 6, 1999.

⁷ The New York Post, February 28, 1999.

We also find that the Trademark Examining Attorney has made a prima facie showing on the second prong of the Section 2(e)(3), i.e., that purchasers are likely to make a goods/place association between the place named in the mark, i.e., Italy, and the goods identified in the application, i.e., "furniture, namely, mobile and stationary computer workstations comprised of shelving, storage and filing systems for computer peripherals, keyboard platforms, computer hardware and computer software." (As noted above, applicant has conceded that its goods do not originate from Italy, the geographic place named in its mark.)

The Trademark Examining Attorney has submitted numerous excerpts of news articles obtained from the NEXIS® automated database which, we find, establish the requisite goods/place association between furniture, including computer workstation furniture, and Italy.⁸ Inter alia,

⁸ The Trademark Examining Attorney performed various searches in the NEXIS® database:

The search ITALY W/2 FURNITURE yielded 373 hits in the ALLNEWS library, 8 of which were printed and made of record;

The search (ITAL! PRE/1 DESIGN!) W/2 FURNITURE yielded 39 hits in the US file of the NEWS library, 27 of which were printed and made of record;

these articles informed their readers: that Italy's contemporary furniture industry is generally regarded as the world leader (Crain's New York Business, May 27, 1991); that Italy's new furniture sales increased from \$16.8 billion in 1997 to \$18 billion in 1998 (The New York Times, April 22, 1999); that the United States is the second-largest customer (after Germany) for Italian-made furniture, having imported \$972 million worth in 1998 (*id.*); and that Italy is the third-largest exporter (behind China and Canada) of office furniture to the United States (The Wall Street Journal, June 18, 1999). The Trademark Examining Attorney also has submitted printouts of the

The search FURNITURE FROM ITALY yielded 100 hits in the US file of the NEWS library, 9 of which were printed and made of record;

The search FURNITURE W/7 "MADE IN ITALY" yielded 17 hits in the US file of the NEWS library, 9 of which were printed and made of record;

The search ITALIAN MADE W/2 FURNITURE yielded 10 hits in the US file of the NEWS library, 5 of which were printed and made of record;

The search (WORKSTATION W/5 COMPUTER) W/30 ITAL! yielded 68 hits in the US file of the NEWS library, 9 of which were printed and made of record;

The search ITALY W/10 NEW FURNITURE yielded 10 hits in the US file of the NEWS library, 2 of which were printed and made of record; and

The search ITALY W/10 CONTEMPORARY FURNITURE yielded 13 hits in the US file of the NEWS library, 5 of which were printed and made of record.

Internet websites of several Italian manufacturers of computer workstation furniture.

We find that the evidence submitted by the Trademark Examining Attorney is more than sufficient to establish, prima facie, that purchasers would assume a goods/place association between the place named in applicant's mark and the goods identified in applicant's application. Thus, for the reasons discussed above, we conclude that the Trademark Examining Attorney has made out a prima facie case in support of both prongs of her Section 2(e)(3) refusal.

We turn next to a consideration of whether applicant has rebutted the Trademark Examining Attorney's prima facie showing under Section 2(e)(3). In its response to the first office action, applicant submitted a listing of third-party registrations which, applicant contends, show that ITALY or ITALIA is extensively used by third parties in marks covering a wide variety of goods and services. As noted by the Trademark Examining Attorney, however, those purported third-party registrations were never properly made of record, and we accordingly give them no consideration. See *In re Pan-O-Gold Baking Co.*, 20 USPQ2d 1761, 1763 at n.7 (TTAB 1991); *In re Duofold Inc.*, 184 USPQ

638, 640 (TTAB 1974).⁹ Thus, the only evidence of record from applicant is a single third-party registration, of the mark PATINA ITALIA for "new, hand-painted furniture," which applicant submitted with its request for reconsideration.¹⁰

We find that applicant's evidence, which consists of the fact that the third-party registration of PATINA ITALIA for "new, hand-painted furniture" was issued on the Principal Register without resort to Section 2(f) or a disclaimer, is insufficient to rebut the Trademark Examining Attorney's prima facie case under Section 2(e)(3). We are not privy to the contents of that application file, nor are we bound by the reasoning or the conclusions of the Trademark Examining Attorney who passed that mark to publication. *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984); *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

Likewise, we are not persuaded by any of applicant's legal arguments in opposition to the Section 2(e)(3)

⁹ However, even if the listed third-party registrations had properly been made of record, our decision would be unchanged. As discussed more fully, *infra*, the factual and legal conclusions applicant would have us draw from these third-party registrations are unwarranted.

¹⁰ Registration No. 2,000,122, issued September 10, 1996. The printout submitted by applicant was obtained from a commercial search company rather from PTO records, but the Trademark Examining Attorney has treated it as being of record, and so shall we.

refusal. Applicant argues that because purchasers are aware that a wide variety of goods and services originate in or from Italy, it is "overreaching" to assume that purchasers would make a goods/place association between Italy and the particular goods identified in the application. This contention has no basis in the evidence of record¹¹ nor in the law. *In re Venice Maid Co., Inc.*, 222 USPQ 618 (TTAB 1984), cited by applicant, does not stand for the proposition that when the place named in the mark is a large city (or country) which presumably could be the source of a wide variety of goods and services, no goods/place association between a place and a particular product can be assumed. Rather, the Board's decision in that case was expressly based on the absence of evidence sufficient to establish the requisite goods/place association between the place and the particular goods. *Id.* at 619. No such lack of evidence exists in the present case.

¹¹ In support of its factual contention that purchasers are aware that a wide variety of goods and services originate in Italy, applicant relies on its listed third-party registrations which, as discussed above, are not part of the evidentiary record in this case. Moreover, third-party registrations are not, in themselves, evidence that the marks depicted therein are in use or that the public is aware of them. *See, e.g., Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Applicant also argues that the primary significance of its mark is not geographic, but rather that its mark is a fanciful, arbitrary term as applied to applicant's goods. It is true that "if there be no connection of the geographical meaning of the mark with the goods in the public mind, that is, if the mark is arbitrary when applied to the goods, registration should not be refused" on the ground that the mark is primarily geographically deceptively misdescriptive. *In re Nantucket, Inc., supra*, 213 USPQ at 893. However, as discussed above, the evidence of record in this case shows that consumers are likely to assume that a connection exists between the country of Italy and a line of furniture of the type identified in the application. The existence of that goods/place association belies applicant's claim that its mark is arbitrary as applied to its goods.¹²

Finally, applicant argues that the primary significance of LINEA ITALIA is not geographic because, as applied to applicant's goods, the mark conveys or identifies a characteristic design style i.e., "Italian

¹² The existence of a goods/place association also distinguishes this case from the case cited and relied on by applicant, *National Lead Co. v. Wolfe*, 223 F.2d 195, 105 USPQ 462 (9th Cir. 1955), cert. denied 350 U.S. 883 (1955), in which the mark DUTCH BOY was found not to be primarily geographically descriptive for paint.

Style" or "Italian-European Style." Again, however, applicant's contention is not supported by the record. Applicant has not identified, and we have not found, any evidence in the record which establishes that there is a style of furniture which, regardless of its geographic origin, would be referred to by purchasers as "Italian Style" or "Italian-European Style." See *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999), *aff'g* 48 USPQ2d 1689 (TTAB 1998)(Section 2(e)(3) refusal of NEW YORK WAYS GALLERY appropriate in absence of any evidence showing a "New York style" of the goods at issue).

In summary, we find that applicant has failed to rebut the Trademark Examining Attorney's prima facie showing that applicant's mark is primarily geographically deceptively misdescriptive of the goods identified in the application, and we accordingly conclude that refusal under Section 2(e)(3) is warranted.

Decision: The refusal to register is affirmed.

R. L. Simms

B. A. Chapman

C. M. Bottorff

Administrative Trademark Judges

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